UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,
Petitioner,

v.

CALIFORNIA INSTITUTE OF TECHNOLOGY,
Patent Owner.

_____

Cases IPR2017-00728
Patent 7,421,032

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PATENT OWNER'S MOTION TO EXCLUDE

TABLE OF CONTENTS

I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c) and the Federal Rules of Evidence, Caltech respectfully moves to exclude Exhibits 1206, 1218, 1219, 1224, 1229-1249, 1257-1261, 1265, 1267, 1268, 1271, 1272 and portions of Exhibits 2038 and 2039. The Federal Rules of Evidence apply to *inter partes* proceedings. 37 C.F.R. § 42.62; *LKQ Corp. v. Clearlamp, LLC*, IPR2013-00020, Paper 17, at 3 (Mar. 5, 2013).

Having recognized that the petition's arguments and evidence cannot sustain a finding of unpatentability, Petitioner has engaged in an improper rehabilitation campaign with new arguments, new evidence, and testimony elicited from out-of-scope questions. The new exhibits must be excluded because they largely lack relevance to any instituted ground, and they are unduly prejudicial to Caltech because Caltech lacks any meaningful opportunity respond to the new evidence. FRE 401; 402; 403.

II. ARGUMENT

A. Exhibits 1244-1249, 1257-1261, 1265, 1268, 1271, and 1272 should be excluded for being new evidence used to support new arguments

Exhibits 1244-1249, 1257-1261, 1265, 1268, 1271, and 1272 were not submitted until after Caltech had filed its Patent Owner Response. To the extent those exhibits were cited in Petitioner's reply, they were cited in support of arguments that were not made in the petition and were therefore improper to raise

for the first time in Petitioner's reply. 37 CFR §42.23(b); *Intelligent Bio-Systems,*

Inc. v. Illumina Cambridge, 821 F. 3d 1359, 1370 (Fed. Cir. 2016). As such, they

are not relevant to the instituted grounds of review. FRE 401; FRE 402.

Exhibits 1244-1249, 1257-1260, 1271, and 1272 are various diagrams,

including Tanner graphs, that were admittedly created by Petitioner's lawyers (*see,*

e.g., Ex. 2038, 415:14-18) and purport to depict the prior art. Many of these

exhibits were first introduced in the depositions of Dr. Mitzenmacher (Exs. 1244-

1249) and Dr. Divsalar (Exs. 1257-1260). The questions relating to these exhibits

were largely attempts to authenticate the exhibits so that Petitioner could rely on

them in its reply to support new arguments. For example, Petitioner cites to

Exhibit 1248 in its reply, claiming that Caltech's expert only had one objection to

it.[1] Reply 9. However, Dr. Mitzenmacher made it clear that "I think that's one

problem I have, there may be others. I may require some time to examine and map

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[1] That one objection, of course, is a meaningful one that underscores a defective

obviousness inquiry that ignored fundamental aspects of how Ping's codes are

constructed, illustrates that the proposed modification breaks the constraints of

Ping's code, and renders the attorney-created graph technically inaccurate and

inapposite. *See e.g.,* POR 7-9, 33-35.

this out in order to see if it was consistent with what Ping had said." Ex. 2038, 427:3-7. Petitioner cannot argue that these exhibits are necessary to respond to Caltech's arguments that the petition was materially flawed.

Exhibit 1268 is purportedly a "[s]imulation of Regular and Irregular Divsalar Codes" conducted by Dr. Frey. Petitioner relies on this exhibit to show that a newly proposed modification to Ping "would not have been difficult for POSA to generate" and "would have had a reasonable expectation of success." Reply 14-16. But the petition *never* discusses reasonable expectation of success, and so the evidence lacks relevance to any of the instituted grounds. There is simply no reason why such evidence or arguments could not have been included in the petition. In addition, the simulation purports to test a Ping code whose $\mathbf{H}^d$ sub-matrix has been modified in two different, specific, and complicated, ways. *See* Ex. 1265 ¶¶48, 52 (depicting the distribution of weights in Petitioner's two new modifications to Ping). The petition never presented these proposed modifications—instead, Petitioner only gave the vague proposal of modifying Ping's $\mathbf{H}^d$ sub-matrix to have "some columns to weight 9 and others to weight 3." Pet. 44. Such a vague proposal did not put Caltech on notice of Petitioner's new complicated modifications, and one of them even admits to have "column weights four, five, or nine." Ex. 1265 ¶52. Thus, the new simulation data must be excluded as it is a completely new and untimely theory not relevant to any

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